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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,646	10/24/2003	John Kevin McCoy	12093/930	8631
26646                      7590                      11/12/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
			EXAMINER LIGHTFOOT, ELENA TSOY	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 11/12/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,646

**Applicant(s)**

MCCOY, JOHN KEVIN

**Examiner**

Elena Tsou Lightfoot

**Art Unit**

1792

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-8,12,17-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,6-8,17-20 and 23 is/are allowed.
- 6) ☒ Claim(s) 12 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

Amendment filed on September 8, 2009 has been entered. Claims 9, 10, 21, and 22 have been cancelled. Claims 1, 2, 6-8, 12-20, 23, and 24 are pending in the application. Claims 13-16 are withdrawn from consideration as directed to a non-elected invention.

Claims examined on the merits are 1, 2, 6-8, 12, 17-20, 23, and 24.

***Claim Objections***

1. Objection to claims 9 and 21 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn due to cancellation of the claims.
2. Objection to claims 10 and 22 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn due to cancellation of the claims.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Rejection of claims 1, 2, 6-10, and 17-23 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to amendment.
5. Claims 12 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention for the reasons of record set forth in paragraph 5 of the Office Action mailed on 8/21/2009.

Applicant's arguments

Applicants argue that with regard to claims 12 and 24, claim 12 recites that the infiltrating of the arrangement with the precursor liquid results in incorporation of the precursor liquid into a center of the arrangement, and claim 24 recites that the infiltrating of the arrangement with the precursor liquid comprises incorporation of the precursor liquid into a center of the arrangement. At page 4, the Office Action states that those claims are indefinite "because it is not clear whether the precursor liquid should be only in the center of the arrangement or in the center as well." Applicant believes that statement in the Office Action is intended to mean that it is not clear whether the precursor liquid is incorporated into the center of the arrangement only or into other parts of the arrangement as well as the center. In response, Applicant submits that a claim that recites that the infiltrating of the arrangement with the precursor liquid comprises or results in incorporation of the precursor liquid into a center of the arrangement clearly encompasses both incorporation of the precursor liquid into the center of the arrangement only and incorporation of the precursor liquid into other portions of the arrangement, as well as incorporation into the center. Applicant is not aware of any part of U.S. patent law that would require the scope of the present claims to be limited to incorporating the precursor liquid into either the center of the arrangement only or other parts of the arrangement, as well as the center of the arrangement and. If such a requirement is part of U.S. patent law, Applicant respectfully requests a citation to the pertinent statute or regulation. Therefore, the present claims will be understood by one of ordinary skill in the art in light of what is known in the art and the disclosure of the present specification, and, thus, the present claims meet the requirements of 35 U.S.C. § 112, second paragraph.

The Examiner respectfully disagrees with this argument. In contrast to Applicants argument, the present claims **do not meet the requirements of 35 U.S.C. § 112, second paragraph**: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention". However, since *neither* claims 12 and 24 *nor* independent claim 1 recite *particular infiltration techniques*, and since claims 12 and 24 recite only **result** of the non-recited infiltrating step, the limitation of claims 12 and 24 "the infiltrating of the arrangement with the precursor liquid results in incorporation into a center of the arrangement" reads on any infiltration techniques including techniques allowing infiltration right into the center of the arrangement, for example, through conduits leading to the center. In other words, without recitation of *particular infiltration technique*, it is not clear from the language of claims 12 and 24 is it incorporation of

the precursor liquid into a center of the arrangement only or through the arrangement? Thus, claims 12 and 24 do not *particularly point out and distinctly claim what subject matter constitutes the invention*,

Note that if claim 1 or claims 12 and 24 recited a *particular infiltration technique*, e.g. a step of *immersing* the pellet into a precursor liquid, the limitation of “incorporation of the precursor liquid into a center of the arrangement” would have been clear.

#### ***Allowable Subject Matter***

Claims 1, 2, 6-8, 17-20, and 23 are allowed over prior art.

Claims 12 and 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1792

November 12, 2009

/Elena Tsoy Lightfoot/